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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,187	08/30/2006	Virginie Caprasse	DC10047 PCT 1	7377

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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12/13/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary	Application No. 10/591,187	Applicant(s) CAPRASSE ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 of 10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 to 10 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Zhong.

Zhong teaches a method of making a silicone resin. See column 3, lines 40 and on. This method comprises contacting a Si-H containing resin with an alkene of from 8 to 28 carbon atoms. The last formula on column 3 is an SiH containing alkyl silsesquioxane. This meets the instant claim.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 6 to 8 and 11 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas.

Thomas teaches a silicone resin used to form a ketoxime functional siloxane. The resin is defined starting on the top of column 2 and contains at least 30 mol% of monoorganosiloxane units. This corresponds to the claimed "y" units. The remaining units can be selected from diorganosiloxane and triorganosiloxane units. Line 74 of column 2 specifically teaches that the triorganosiloxane units can be octadecyldimethylsiloxane. This corresponds to the claimed "x" units. Thus while not specifically showing a siloxane resin having both the required units, Thomas teaches that such units can be present in the siloxane resin therein. One having ordinary skill in the art would have found the presence of octadecyldimethylsiloxane units in combination with monoorganosiloxane units to have been obvious. In this manner the instant claims are rendered obvious.

For claim 3, note column 6, line 45, which teaches organic solvents.

For the remaining claims, note that the products claimed are defined only by the siloxane resin. Nothing else is required for these products.

5. Claims 1 and 3 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berthiaume et al. in view of Yeoh et al.

Berthiaume et al. teach MQ siloxane resins. The "M" units in these resins meet the required "x" unit of claim 1. See for instance column 6, lines 42 and on. This also teaches a hydrosilylation preparation method (such as found in claim 9). The MQ resins therein are used in cosmetic compositions. Berthiaume et al. differ from that claimed in that it does not teach a silsesquioxane, or MT, resin.

Yeoh et al. teach siloxane resins used in cosmetic compositions. As can be seen from column 13, line 50, through column 14, siloxane resins are highly crosslinked siloxane systems having tri- and tetrafunctional siloxane units. Tri- and tetrafunctional units are present in a sufficient level of crosslinking such that they dry down to a rigid or hard film. Column 14, lines 50 and 51 indicate that MQ and MT silicone resins can be used in the alternative.

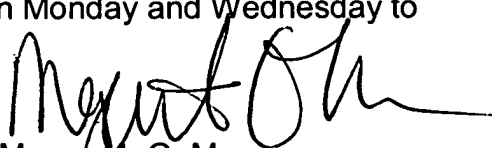
As noted in Yeoh et al., it is the presence of the T and Q units which provide the desired degree of crosslinking and both MQ and MT resins can be used in the alternative in cosmetic compositions. Note that it is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. One having ordinary skill in the art would have found the use of an MT siloxane resin rather than an MQ siloxane resin to have been obvious, as per the teachings in Yeoh et al. As such the skilled artisan would have been motivated to use an MT siloxane resin in place of the MQ resin of Berthiaume et al. to have been obvious. found an .

In the instant application it appears that applicants are merely using a different type of known siloxane unit in an effort to obtain a siloxane resin. While this may alter the final properties of the siloxane resin, it will do so in a predictable manner since, as indicated by Yeoh et al., it is understood in the art that the degree of crosslinking will vary according to the specific siloxane units used.

6. The remaining references are cited as being of general interest. Amako et al. teach a siloxane having the claimed "x" units but fails to teach or suggest "y" units. Albaugh et al. teach siloxanes resins but also fail to teach or suggest the necessary combination of "x" and "y" units.

7. Claim 2 is objected to as being dependent upon a rejected base claim but containing allowable subject matter. The prior art fails to teach or suggest a silane resin having each of the claimed siloxane units of claim 2.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.



Margaret G. Moore
Primary Examiner
Art Unit 1796

mgm
12/9/07